

REMARKS

In the Office Action, the Examiner objected to claims 9, 14 – 21, 28, 29, 31 and 32 and required tuning of the claim language structure, rejected claims 1 – 3, 5, 6, 8, 9, 14 – 21, 28, 29, 31 and 32 under the first paragraph of section 112, and provisionally rejected claims 31 and 32 for double patenting.

Telephone Interview

Applicants' representative contacted the Examiner by telephone to discuss the "tuning" requirement and the biological deposit requirement. In the first telephone discussion on March 13, 2008, the Examiner reported that he would check the file and contact the undersigned with additional information. In the second telephone discussion on March 26, 2008, Applicants' representative directed the Examiner's attention to the Budapest Treaty Recognition of Deposit International Form that was submitted in this application on August 7, 2007. Applicants' representative asserted that the certificate would meet the affidavit requirement, to which the Examiner pointed out the missing date information in section IV of the certificate.

During the telephone discussions, Applicant requested a clarification as to what tuning is required in the claim language. The Examiner noted that claim 9 may require reference to phenotype and homozygote. When further clarification was requested, the Examiner indicated that the Examiner's supervisor may have more information on this issue. Two telephone calls were made to the Examiner's supervisor following the Examiner's suggestion, but these were not returned.

Claim Objection

During the two telephone discussions noted above, Applicants' representative sought clarification as to the nature of the objection to the claim language. In the second telephone discussion, the Examiner commented that the terms "phenotype" and "homozygote" should be used in claim 9. Applicants have considered this suggestion but are at a loss as to how to incorporate these terms into a claim to a homologous recombination vector. The vector claimed in claim 9 is used in the isolated host cell of claim 14, for example. The claim 9 is not directed to the homologous individual, or homozygote.

Clarification of the objection is hereby requested, including identification of any claim terms that may be unclear or a more specific suggestion for a claim structure or wording.

35 USC §112, 1st ¶

Applicants respectfully submit that the subject matter of the claim is enabled by the specification. Enablement is provided by the biological deposit identified as pHR53TK in the CECT under access number CECT5737. The biological deposit is cited in the specification and an International Form under the Budapest Treaty was submitted. The deposit form is found in the PAIR system in a document dated 08/07/2007 that is identified as document code “NPL”, document description “NPL Documents” and document category “Prior Art”. Clearly, the document category is misidentified in the Patent Office file.

The deposit certification shows that the deposit was received and accepted on 4 October 2002 (as shown in section III). The deposit certification is missing the dates under section IV, but it is apparent that the first date, the date of receipt of the deposit in section IV, would be the date shown in section III, i.e. 4 October 2002. The deposit is being maintained as a deposit under the Budapest Treaty as is apparent by the use of the form BP/04, and the seal, signature and date of the authorized official representing the International Depository Authority. As such, the only item missing from the form is the date that the depositor requested that the deposit be converted to a deposit under the Budapest Treaty. Applicants submit that this missing item of information is de minimis and does not indicate a lack of enablement of the claimed invention.

In the Office Action, the Examiner requested an affidavit that the biological deposit has been accepted by an International Depository Authority under the provisions of the Budapest Treaty. The certificate paper submitted previously shows that the biological deposit has been made under the Budapest Treaty. Applicant submits that the affidavit requirement has been met by the filing of the certificate.

Applicants note that this same certificate was filed in the European Patent Office for the corresponding European Application and was been accepted without any problem. See for example the published European Application EP 1 752 540 A2 at paragraph [0093], wherein the biological deposit is cited.

Double Patenting

The provisional double patenting rejection is addressed by cancelling claims 31 and 32. The claims are cancelled without prejudice. Applicants submit that the provisional rejection is overcome.

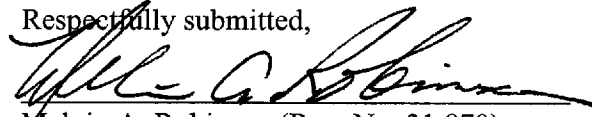
Conclusion

Applicants respectfully request favorable reconsideration and allowance of the present application in view of the forgoing.

Deposit Account Information

The Commissioner is hereby authorized to charge any additional fees which may be required or to credit any overpayment to account no. 501519.

Respectfully submitted,



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